REMARKS/ARGUMENTS

Status of the Claims

Claims 1 through 32 are currently pending in this response. All of the claims have been finally rejected as obvious under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (U.S. Patent Application Publication Number 2001/0018739) in view of Dutta et al. (U.S. Patent Application Publication Number 2002/0152164).

Remarks

The Examiner stated that the Applicant's arguments filed December 5, 2007 were fully considered but not persuasive. Applicants again respectfully traverse and request reconsideration of the rejection, because all of the limitations of the independent claims are not taught or suggested by the prior art. It is well established that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03.

Applicants respectfully submit that a *prima facie* case of obviousness has *not* been established – and Applicants intend to appeal these rejections if they are not withdrawn.

In the hope of advancing the prosecution more speedily than an appeal, Applicants focus solely on the independent claims (which, if allowable, render the dependent claims allowable) and substantively reply to the Examiner's response to applicant's arguments as follows:

- *Claim 1: Neither Anderson nor Dutta provide software or methods for generating a downloadable index of images of cleared paper checks together with complementary software for downloading the index together with the images of the cleared paper checks.*

Here, the combination of Anderson and Dutta does not teach the following limitations found in method claim 1:

- providing an index generating software program to a financial institution for use on a first computer that generates a downloadable index of images of cleared paper checks;
- providing complementary software to a customer that is operable to remotely download the downloadable index of images of cleared paper checks, together with the images of the cleared paper checks, and to display the images of the cleared paper checks.

Likewise, the combination of Anderson and Dutta does not teach the following limitations found in apparatus claim 15:

- index generating software on a remote computer serving a financial institution that generates indexes of images of cleared paper checks maintained for the financial institution; and
- an index downloading software module residing on a customer's personal computer that

is operable to remotely access and download the index together with the cleared paper check images.

The Examiner argued that "Anderson teaches paper check when he discloses the steps of making electronic payments on public networks wherein it may be used in any situation where a paper check would be used," citing ¶¶ 222 & 249. (OA at 2-3). But Anderson does not disclose or suggest that *paper* check images would be incorporated into an index. Anderson also does not teach that complementary software would be provided for customers to download the index, together with the images of the cleared paper checks, and operable to display those images.

The Examiner also argued that "Anderson teaches providing an index when he creates an index," citing ¶¶ 18 & 27. (OA, at 3). But these paragraphs – found in a lengthy, rambling (and not fully relevant) background section of Anderson – do not remotely suggest that an index be generated of cleared checks, much less cleared *paper* checks.

Dutta likewise fails to provide software or methods for generating a downloadable index of images of cleared paper checks, or of complementary software for downloading them. The Examiner argued that "Dutta specifically discloses to display the images of the cleared paper checks," citing ¶¶ 3 and 20 and Figs. 13-14 (OA, at 4). Dutta discloses an ATM machine with a scanner to scan paper checks deposited by customers and that transmits those images to the financial institution. But Dutta does not disclose or suggest a downloadable index of images of cleared paper checks, or complementary software that allows customers to download them.

Because the combination of Anderson and Dutta fail to disclose all the limitations of claim 1, there is no prima facie basis for rejecting the claim as obvious over these references.

- *Claim 6: Neither Anderson nor Dutta provide software or methods for providing checking account customers with a financial transaction bookkeeping program operable to download and display paper check images through a checking account ledger.*

The combination of Anderson and Dutta also does not teach the following limitations found in independent claim 6:

- providing a checking account customer of a financial institution with access over a network to images of paper checks that have cleared the customer's checking account;
- providing the customer with a financial transaction bookkeeping program that downloads and stores copies of the cleared paper checks images and presents images thereof through a checking account ledger;

The Examiner did not explain how the combination of Anderson and Dutta teach these elements. The Office Action rejected claim 6 on the presumption that it was substantively identical to claim 1.

Clearly, the combination of Anderson and Dutta fail to disclose all the limitations of

claim 6. Therefore, there is no prima facie basis for rejecting the claim as obvious over these references.

- *Claim 21: Neither Anderson nor Dutta provide software or methods for providing checking account customers with a software program operable to download and store digital archives of cleared paper check images drawn from their accounts.*

The combination of Anderson and Dutta does not teach the following limitations found in method claim 21:

- providing a financial institution software program that periodically generates digital archives of cleared paper check images for an account customer;
- providing an account customer with secure online access to the digital archives and enabling the customer to download and store the digital archives of cleared paper check images.

The Examiner argued that "archives" are not recited in claim 21. (OA, at 2). Applicants respectfully disagree.

The Examiner also argued that Anderson "teaches archives when he discloses issuer bank keeps an archive of electronic checks," citing ¶¶ 178, 198, 206, and 242. But the *claim* recites digital archives of cleared *paper* checks, not *electronic* checks. The cited paragraphs from Anderson merely state that an archive of *electronic* checks is created. Furthermore, neither Anderson nor Dutina teach giving an account customer secure online access to digital archives of cleared *paper* checks and enabling them to download and store them.

Because the combination of Anderson and Dutta fail to disclose all the limitations of claim 21, there is no prima facie basis for rejecting the claim as obvious over these references.

- *Claim 31: Neither Anderson nor Dutta provide software or methods for providing checking account customers with a software program operable to download and store digital archives of cleared paper check images drawn from their accounts.*

The combination of Anderson and Dutta does not teach the following two limitations, in combination, found in method claim 31:

- creating a search index of preselected check information that is linked to the corresponding images of a financial account customer's paper checks and transactions; and
- downloading the images and index from the financial institution into a computer software application on the customer's computer system that allows the customer to search the preselected fields and view any of the corresponding paper check images.

The Examiner argued that "Anderson teaches paper check when he discloses the steps of making electronic payments on public networks wherein it may be used in any situation where a

paper check would be used," citing ¶¶ 222 & 249. (OA at 2-3). But Anderson does not disclose or suggest that *paper* check images would be incorporated into an index. Anderson also does not teach the use of software on a customer's computer system to download the index, together with the images of the cleared paper checks, and that enables them to search preselected fields and view any of the corresponding paper check images.

The Examiner also argued that "Anderson teaches providing an index when he creates an index," citing ¶¶ 18 & 27. (OA, at 3). But these paragraphs – found in a lengthy, rambling (and not fully relevant) background section of Anderson – do not remotely suggest that an index be generated of cleared checks, much less cleared *paper* checks.

Dutta likewise fails to provide software or methods for generating a downloadable index of images of cleared paper checks, or of complementary software for downloading them. The Examiner argued that "Dutta specifically discloses to display the images of the cleared paper checks," citing ¶¶ 3 and 20 and Figs. 13-14 (OA, at 4). Dutta discloses an ATM machine with a scanner to scan paper checks deposited by customers and that transmits those images to the financial institution. But Dutta <u>does not</u> disclose or suggest a downloadable index of images of cleared paper checks, or software running on the customer's computer that allows them to download the index.

Clearly, the combination of Anderson and Dutta fail to disclose these limitations of claim 31. Therefore, there is no prima facie basis for rejecting the claim as obvious over these references.

Conclusion

Applicants respectfully submit that the foregoing amendments and remarks distinguishing the invention from the cited prior art are sufficient to put the claims in a condition for allowance. Should the Examiner desire to sustain any rejections, the courtesy of a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at (719) 689-0700 is respectfully requested in advance.

Believing that all things raised in the Examiner's February 11, 2008 Office Action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully submitted,

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